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10/777,708

02/12/2004

James W. Voegele

END-5017NP

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27777 7590 12/22/2006  
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EXAMINER

DAWSON, GLENN K

ART UNIT

PAPER NUMBER

3731

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
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3 MONTHS

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/777,708

Applicant(s)

VOEGELE ET AL.

Examiner

Glenn K. Dawson

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 20-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>04-24-2006</u>  | 6) <input type="checkbox"/> Other: _____                          |

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### ***Claim Objections***

Claim 23 is objected to because of the following informalities: it is unclear if a 3<sup>rd</sup> lever arm is being claimed since it is prefaced by "a" instead of "the" or "said".

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 20, 22 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Wallace-3971270.

Wallace discloses a finger-mounted instrument having two jaws and two lever arms 10 and 12. The jaws and arms overlap. The lever arms form a substantially u-shaped member as shown in fig. 5. From pt 38 along arm 10 to 18 and then to 20 along arm 12 and ending at 40 constitutes a substantially u-shaped structure. The jaws are curved as seen in fig. 5 and 22, 24 are the fastening elements.

Claims 20-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Johnson, et al.-3399456.

Johnson discloses an instrument having two jaws and two arms, both of which overlap as shown in fig. 1 and 6. The arms form a u-shaped structure as seen in fig. 1 going from the pivot pin 14 back along each of the arms 17. The finger mount is 20,24. The jaws are curved as shown in fig. 1 and the fastening element can be either the spring 18 or the pivot pin 14.

Claims 20,22 and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Dryer-6776616.

Dryer discloses an instrument in fig. 6 having two curved jaws 612,614 and two arms 602,604. The arms overlap and are pivotably fastened together by pin 610. The arms form a u-shape structure going from right to left with the curved portion 606 forming the bottom of the "u", and the arms 602 and 604 forming the arms of the "u".

Claims 20-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Witt-1117740.

Witt discloses a pair of tweezers for removing bones from a fish. The device has curved jaws 5 connected to lever arms 6. The lever arms are pivotably fastened together by pin 4. The arms to the left of the pin 4 form a u-shaped structure and the device has a finger mount 9. Since the device is used to remove bones from fish during eating, the user would inherently incise (cut with a knife) the fish forming an opening through which the jaws inserted and the jaws are used to grasp tissue (bone) and remove it from the body of the fish.

Claims 20-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Meyers, et al.-5925064.

Meyers discloses a pair of forceps which include curved jaws attached to overlapping lever arms. The lever arms taken from the point at which they are fastened together by pivot pin 43 form a u-shaped structure. The bottom of the "u" would be at the pivot point 43 and the arms of the "u" would extend along the arms 30,42. Attached to one arm is a finger mount 20,22,23 attached by fastener 50 to the lever arm 30. The device is used laparoscopically by placing the device on a finger and placing it through the incision where it is used to grasp or dissect tissue.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Witt-'740.

Witt discloses the method as claimed with the exception of the jaws being used to dissect tissue. The examiner contends that in the normal operation of removing bones from fish, the user would inherently push the jaws against neighboring tissue around the bone, thus dislodging it from the neighboring tissue, thus meeting the claimed limitations.

Claims 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meyers, et al.-5925064 in view of Levin-6001120, or Pilling-5522839, or Boche, et al.-6280458, or Hunt, et al.-6358268

Meyers discloses the invention as claimed with the exception that the disclosed forceps are used to perform a blunt dissection each of the references teaches that it was known to employ forceps or pivotable jaws to perform dissection or blunt dissection by either grasping tissues and pulling them away from neighboring tissues, or by pivoting the jaws away from each other. It would have been obvious to have used the forceps-type device of Meyers to perform a dissection or blunt dissection in view of

these teachings in order to be able to perform different functions with the same instrument, thus one device could perform the grasping and dissecting functions.

### ***Response to Arguments***

Applicant's arguments filed 10-17-2006 have been fully considered but they are not persuasive.

The applicant argues that the references do not disclose the distal sections of the arms overlapping. This is not persuasive as it is clear in each case that the ends of the arms which attach to the jaws do indeed overlap. Some overlap vertically, others horizontally. The u-shaped structure has been outlined for each of the art rejections. The aperture is no longer claimed. Therefore, either the outer portion of the arms can "slidably receive a finger from the proximal end to the distal end, or the space between the arms can receive a finger.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Glenn K. Dawson whose telephone number is 571-272-4694. The examiner can normally be reached on M-Th 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Glenn K Dawson  
Primary Examiner  
Art Unit 3731

Gkd  
13 December 2006